



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/766,517 | 01/28/2004 | Andrew H. Robbins | 13214-003001 | 2227 |
| 26161 7590 03/27/2008 FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022 | | | | |
| EXAMINER ANDREI RADU | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 4137 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 03/27/2008 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/766,517

Applicant(s)

ROBBINS ET AL

Examiner

RADU ANDREI

Art Unit

4137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 01/28/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 01/28/2004 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. This office action is in response to the initial filing on 01/28/2004. The benefits of the provisional application from 01/28/2003 have been considered. Claims 1-26 are currently pending and are considered below.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 6, 9-12, 14-20 and 26 are rejected under U.S.C 102(b) as being unpatentable over Walker et al (US Patent NO. 5,794,207) ("Walker").

4. Regarding claim 1, Walker discloses: A method comprising:

- a) receiving a request for a product; (column 8, lines 46-49)
- b) receiving a unique user identification; (column 8, lines 56-65; column 13, lines 1-5; column 16, lines 51-58)
- c) sending the product request and user identification to a database server; (column 8, lines 56-65)
- d) processing the product request and user identification in conjunction with a set of rules in the database server (column 8, lines 56-65); and

Art Unit: 4137

- e) storing the product request (figure 2, element 250; figure 3, element 360; column 12, lines 3-7; column 15, lines 17-20).
5. Regarding claim 2, Walker discloses: The method of claim 1 (see claim 1 rejection above) in which the product request is a specific menu item. (column 10, lines 40-46; column 16, lines 13-20; column 19, lines 32-37)
6. Regarding claim 3, Walker discloses: The method of claim 1 (see claim 1 rejection above) in which the product request is a specific stock keeping unit (SKU) (column 31, lines 35-40).
7. Regarding claim 4, Walker discloses: The method of claim 1 (see claim 1 rejection above) in which the product request is a family of menu items. (column 8, lines 49-56; column 16, lines 3-8; column 19, lines 32-37)
8. Regarding claim 6, Walker discloses: The method of claim 1 (see claim 1 rejection above) in which the product request is a category. (column 8, lines 49-56; column 10, lines 40-46; column 16, lines 3-8; column 19, lines 32-37)
9. Regarding claim 9, Walker discloses: The method of claim 1 (see claim 1 rejection above) in which the product request is a specific menu item. This claim is identical to claim 2.

10. Regarding claim 10, Walker discloses: The method of claim 1 (see claim 1 rejection above) in which the stored product request represents a number of items. (column 8, lines 49-56)

11. Regarding claim 11, Walker discloses: The method of claim 1 (see claim 1 rejection above) in which the stored product request represents a percentage discount of an item. (column 31, lines 14-40)

12. Regarding claim 12, Walker discloses: The method of claim 1 (see claim 1 rejection above) in which the stored product request represents a dollar discount of an item. (column 31, lines 14-40)

13. Regarding claim 14, Walker discloses: The method of claim 1 (see claim 1 rejection above) in which the stored product request represents a percentage discount of an item. This claim is identical to claim 11.

14. Regarding claim 15, Walker discloses: The method of claim 1 (see claim 1 rejection above) further comprises adding additional product. (column 13, lines 5-10).

15. Regarding claim 16, Walker discloses: The method of claim 1 (see claim 1 rejection above) in which storing further comprises adding rewards. (column 13, lines 5-10; column 31, column 32, lines 23-25).

16. Regarding claim 17, Walker discloses: The method of claim 1 (see claim 1 rejection above) in which sending comprises variable length messages. (column 18, line 66 through column 19, line 12)

17. Regarding claim 18, Walker discloses: The method of claim 1 (see claim 1 rejection above) further comprising performing an examination of available funds. (column 9, lines 31-44; column 17, lines 26-45; column 21, lines 45-61; column 22, lines 20-33).

18. Regarding claim 19, Walker discloses: The method of claim 1 (see claim 1 rejection above) in which the request originates for a point-of-sale (POS) terminal. (under the broadest reasonable interpretation requirement, the user stations shown in figure 3 and figure 4 are POS configurations)

19. Regarding claim 20, Walker discloses: The method of claim 1 (see claim 1 rejection above) in which the request originates from remote network terminal. ("buyer interface" in figure 1; "network interface" in figure 1)

20. Regarding claim 26, Walker discloses: A system comprising;
- a) a point-of-sale (POS) terminal having a POS database; (under the broadest reasonable interpretation requirement, the user stations shown in figure 3 and figure 4 are POS configurations)
 - b) a link to a server database having a plurality of rules ("seller modem", "buyer modem" in figure 1); and
 - c) a link to a device for uniquely identifying a user and for storing a product representation. ("network interface link" in figure 2)

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 5, 7, 8, 13 and 21 are rejected under U.S.C 103(a) as being unpatentable over Walker et al (US Patent NO. 5,794,207) ("Walker").

23. Regarding claim 5, 7, 8, 13 Walker does not specifically disclose a family of SKU items, however, he teaches creating a product request (column 15, line 45 through column 16, line 62), a request for multiple items (column 31, lines 15-20), and a request including a SKU (column 31, lines 35-40). Therefore, a predictable result of Walker

Art Unit: 4137

would have been to create a request for a plurality of items, where each item has a SKU, discounted item, etc. (*KSR International Co. v. Teleflex Inc.* 82 USPQ2d 1385 (2007)).

24. Regarding claim 21, Walker does not specifically disclose a kiosk. On the other hand, Walker discloses buyer and seller interfaces as any electronic or voice communication system (column 14, lines 50-65). Therefore, as a kiosk that sends a request is at least an electronic communication system, the prior art necessarily renders obvious Applicant's claim.

25. Claims 22-25 are rejected under U.S.C 103(a) as being unpatentable over Walker et al (US Patent NO. 5,794,207) ("Walker") and in view of Herwig (US Publication No. 2002/0082925) ("Herwig").

26. Regarding claims 22-25, Walker does not specifically disclose the device being a loyalty card, PDA, payment card or smart card. On the other hand, in addition to storing request at the central computer (figure 1, element 200) Walker at least suggests storing the order request on a user computer (column 22, column 52 through column 23, line 18). However, Herwig teaches storing a request (e.g. shopping list) on a user device (e.g. smart card, loyalty card, payment, PDA) ([0024], [0034], [0035], [0044], [0052]). It would have been obvious to combine Walker's teachings with Herwig's in order to allow

a user to keep a record of the requested purchase (Walker, column 22, column 52 through column 23, line 18)).

CONCLUSIONS

27. The prior art made of record and not relied upon which is considered to be pertinent to applicant's disclosure:

- US 20030036981; Vaughan, Richard A. et al. – contains SKU definition ([0067], [0070])
- US 5926796 A; Method and apparatus for selling subscriptions to periodicals in a retail environment Walker; Jay S. et al.
- US 5937391 A; Point-service system in online shopping mall; Ikeda; Sekio et al.
- US 6334112 B1; Method and apparatus for selling subscriptions to periodicals in a retail environment Walker; Jay S. et al.
- US 6389402 B1; Systems and methods for secure transaction management and electronic rights protection; Ginter; Karl L. et al.
- US 20020138343 A1; Method of providing merchant rebates to purchasers Weatherford, Harry et al.
- US 6470322 B1 Method and apparatus for selling subscriptions to periodicals in a retail environment Walker; Jay S. et al.
- US 20030236755 A1 Enhanced point-of-sale system; Dagelet, Richard JR.

Art Unit: 4137

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to RADU ANDREI whose telephone number is (571)270-5283. The examiner can normally be reached on Mo-Thurs 8am-5pm.

29. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on 571.272.6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

30. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/RADU ANDREI/
Examiner, Art Unit 4137

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 4137